

Remarks

Reconsideration of the application as amended is respectfully requested.

Claims 1-120 are in the application. In view of a previous election, claims 1-31 are presently pending with claims 32-120 having been withdrawn from consideration. Claims 1, 20, 21, 26 and 27 have been amended.

At the onset, the undersigned would like to thank the Examiner for courtesies extended during a telephone interview with Mr. Ludomir Budzyn. The substance of that interview is generally summarized below.

In the Official Action, the Examiner rejected claims 1-31 under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the enablement requirement. The Examiner asserted that "the instant [claimed] apparatus can function at the condition where the second layer (a non-conductive material) contacting the pore (where cells attach) is removed, not as the recited feature where this non-conductive material spans across the pores because there would be no flow of electricity for the non-conductive second layer if it spans across the pores."

The claimed invention is directed to an apparatus usable for high throughput screening (HTS) for measuring cellular electrical conditions. The claimed apparatus has two states. The initial, first state calls for the claimed structure of claim 1, wherein there is provided "a first layer comprising a non-conductive material comprising a top surface and bottom surface and including one or more pores each extending between, and through, said top and bottom surfaces" and a second layer "comprising a non-conductive, sealant material which directly contacts the first layer". As noted by the Examiner, the second layer spans across at least one of the pores of the first layer in this initial state. The device is initially prepared with an intact sealant layer across at least one pore of the first layer.

During use, the claimed apparatus achieves a second state, wherein openings are formed through the second sealant layer, corresponding to cell locations in the pores of the first layer. Specifically, the sealant layer is ablated (e.g., by enzymes or photo-ablation) where cells have been positioned in the pores, ready for testing. Where pores are not contacted by cells, the sealant material is left intact and not ablated. Open pores with no contacted cells prevent the ability to obtain accurate electrical testing. The subject invention seeks to create only open

pores where cells are located to enhance the ability to conduct testing. In this manner, open pores, with no contacted cells, can be greatly avoided.

Claim 1 is directed to the claimed apparatus being in an initial state. As correctly noted by the Examiner, pores must be formed in the sealant layer to allow for proper electrical measurement. Claims 20 and 26 reference the second state where portions of the sealant material are selectively removable. It is respectfully submitted that claims 1-31 are enabled and are in accord with 35 U.S.C. §112.

Applicants also seek to note for the record that U.S. Patent No. 6,379,916 to Meyer, which is mentioned in the Office Action, is distinguishable from the subject invention. In particular, there is no disclosure or suggestion in Meyer of the use of a sealant layer as set forth in the claims. In Meyer, a cell support structure 1 with pores formed therethrough is provided with a filter 4 adjacent thereto. (column 3, lines 63-65). As explained at column 3, lines 27-35, the filter 4 allows for rinsing of the substrate 1 from its rear side. The filter 4 is provided to allow passage of the rinsing fluid, yet to prevent blockage of the pores in the substrate 1 by small particles. The filter 4 is not formed of a non-conductive, sealant material as set forth in claim 1. It is respectfully submitted that claim 1, along with dependent claims 2-31, are patentable over Myer.

Applicants also seek to raise a procedural issue. It is noted that the present Office Action has been declared final. As set forth in MPEP §706.07(a), an Office Action should not be declared "where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement". It is respectfully submitted that the basis of the rejection in the outstanding Office Action is a new grounds of rejection which had not been previously applied. Furthermore, this grounds of rejection was not necessitated by Applicants' amendment nor based on new art cited by the Applicants. It is respectfully requested that the finality of the Office Action be withdrawn pursuant to MPEP §707.07(e).

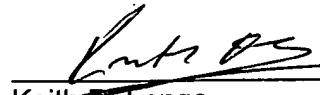
Conclusion

In view of the remarks made herein, Applicants respectfully submit that the claims are in condition for allowance and favorable action is, therefore, respectfully requested.

Please direct any questions concerning this Response or any aspect of this case to the undersigned attorney.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Account No. 19-3880 in the name of Bristol-Myers Squibb Company.

Respectfully submitted,


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